



130-122
#29
12-1-25
180
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Adams *et al.*

Serial No. 08/113,561

Filed: August 25, 1993

For: METHODS AND COMPOSITIONS
FOR THE PRODUCTION OF
STABLY TRANSFORMED,
FERTILE MONOCOT PLANTS
AND CELLS THEREOF

§
§
§
§
§
§
§
§
§
§
§

Group Art Unit: 1804

Examiner: G. Benzion

Atty. Dkt.: DEKM:055/PAR

\$130.00
REFUND SCHEDULED

Dec.

AUG 30 1995

By Treasury Clerk in approximately
100 (10) days from above date
CHIEF ACCOUNTING OFFICER
PATENT TRADEMARK OFFICE

PETITION TO THE COMMISSIONER UNDER 37 C.F.R. 1.181(a)

AND

SECTION 1002.02(c)4(d) OF THE MPEP

RECEIVED

NOV 21 1995

GROUP 1800

The Honorable Commissioner
of Patents and Trademarks
Washington, D.C. 20231

Sir:

I hereby certify that this correspondence is being
deposited with the United States Postal Service as
first class mail in an envelope addressed to: Commis-
sioner of Patents and Trademarks, Washington, D.C.
20231, on October 18, 1995

(Date of Deposit)

David L. Parker

Name of Applicant, assignee, or
Registered Representative

Signature

October 18, 1995

Date of Signature

The Applicant requested an insertion of text into the specification of the referenced patent application in an Amendment filed on December 28, 1994 in order to partially correct an unintentional deletion of text from the specification as originally filed. In an Office Action dated April 17, 1995, the Examiner objected to the insertion of text as new matter under 35 U.S.C. §132 and required the Applicant to cancel the inserted text. The Applicants hereby petition from the Examiner's above mentioned objection to the insertion of new text into the specification.

300 SC 11/02/95 08113581
1 122 130.00 CK

The specification of the referenced patent application was unintentionally deficient in approximately one page of text following page 149 of the specification as originally filed. As a result of this deficiency the text bridging pages 149 to 150 is confusing to the reader. In an Amendment submitted on December 28, 1994, the Applicant sought to alleviate this deficiency through deletion of the words "Two samples were" at line 30 of page 149 and insertion of text at the top of page 150 of the specification that would bridge the gap created by the missing text. Insertion of the following text was requested:

--G. Identification of Transformed Cells Using Selectable Markers

In order to improve the ability to identify transformants, one may employ a selectable marker gene that encodes a selectable marker that confers a trait which one can select for by chemical means, i.e., through the use of a selective--

The Examiner in an Office action dated April 17, 1995, (paper number 20) objected to the insertion of new text, on the basis that it introduced new matter into the disclosure of the specification.

The Applicants respectfully submit that the insertion of the heading "G. Identification of Transformed Cells Using Selectable Markers" is desired in order to make the specification consistent, after sub-section "F" (at page 134) and before sub-section "H" (at page 169). The language of subheading "G" takes the form also used for sub-heading H (page 169) which relates to the "Identification of Transformed Cells Using Screenable Markers." The use of

selectable markers to identify transformants is clearly supported by the specification at page 24:

In order to improve the ability to identify transformants, one may desire to employ a selectable or screenable marker gene as, or in addition to, the expressible gene of interest. (emphasis added)

Therefore, the Applicants submit that the desired heading which is to be inserted is fully supported by the specification of the patent application as originally filed.

The Applicants further submit that the text to be inserted in the specification after the heading is fully supported by the specification of the patent application. On page 24 of the specification it is stated that:

In order to improve the ability to identify transformants, one may desire to employ a selectable or screenable marker gene as, or in addition to, the expressive gene of interest. Marker genes" are genes that impart a distinct phenotype to cells expressing the marker gene and thus allow such transformed cells to be distinguished from cells that do not have the marker. Such genes may encode either a selectable or screenable marker, depending on whether the marker confers a trait which one can 'select' for by chemical means, i.e., through the use of a selective agent (e.g., a herbicide, antibiotic, or the like), or whether it is simply a trait that one can identify through observation or testing, i.e., by 'screening' (e.g., the R-locus).

It is clear that the text following the heading "G." to be inserted in the specification of the referenced patent application is an almost exact repetition of the text present in the specification at page 24. Insertion of this text is required in order to make the sentence ending in "agent" at the top of page 150 a complete sentence.

In *In re Oda*, 170 U.S.P.Q. 268 (CCPA 1971), the C.C.P.A. held that the court must decide on a case-by-case basis what changes are prohibited as new matter. The court, however, stated that underlying a decision as to addition of new text to a patent specification is

"the clear and basic concept that the invention described in the original patent must not be changed." In the present instance, the Applicant's invention is directed to transformed corn plants that express particular pre-selected genes. It is clear that the insertion of the desired text into the specification does not change the invention described in the application as the text repeats almost exactly words found elsewhere in the specification. The inserted text merely serves to prevent confusion of the part of the reader of the specification.

Furthermore, the court in *Oda* stated that:

... one skilled in the art would appreciate not only existence of error in the specification but what the error is. As a corollary, it follows that when the nature of this error is known it is also known how to correct it.

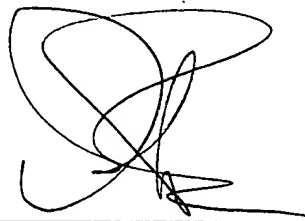
170 U.S.P.Q. at 272.

In that the nature of requested amendment is very minor and subject matter sought to be introduced into the specification is clearly disclosed in other parts of the specification, there is no basis for in any way concluding that one of skill would not appreciate that the specification embraced this subject matter when the application was filed.

In the present instance the Applicants acknowledge that a page of text was unintentionally omitted from the originally filed specification and seek to correct the omission by insertion of text that is repeated elsewhere in the specification and which will assist the reader of the patent specification to clearly understand the nature of the invention. For the foregoing reasons, it is respectfully submitted that the Examiner erred in objecting to

the insertion of the desired text into the specification of the referenced patent application, and reversal of that decision is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, consisting of several loops and a long horizontal stroke at the bottom, positioned above a solid horizontal line.

David L. Parker
Reg. No. 32,165

ARNOLD, WHITE & DURKEE
P.O. Box 4433
Houston, Texas 77210
512-418-3000

Date: October 18, 1995